

REMARKS

Reconsideration of the above-identified patent application in view of the amendment above and the remarks below is respectfully requested.

Claims 12-18, 20, 23, 25-31 and 33-36 have been canceled in this paper. Claims 11, 19, 21, 24, 32 and 37 have been amended in this paper. No claims have been added in this paper. Therefore, claims 11, 19, 21-22, 24, 32, 37, 41-42 and 44-47 are pending and are under active consideration.

Claims 11-37 and 41-47 stand rejected under 35 U.S.C. 103(a) "as being unpatentable over Bone (4,039,078) and Mori et al. (6,433,106)." In support of the rejection, the Patent Office states the following:

Bone '078 discloses a length of continuously connected fastener stock comprising: first and second side members (60A and 60B); and a plurality of cross-links (60C) interconnecting said first and second side members. The side members have an augmented transverse cross-sectional size. Bone '078 discloses (column 6, lines 17-21 and lines 29-35) that the side members and the cross-links may take many forms such as oval, triangular, octagonal, circular, etc. See Figures 1-9 embodiments. Bone '078 does not appear to teach the specific shape of the fasteners and the process of using Rotary molding. As admitted by applicant cross-links that have both a flat surface and an arcuate surface are well known in the art. (Figures 1-6 embodiment of the instant application).

Therefore, with respect to the shape and size of the side members and cross-links it would have been an obvious matter of design choice to modify the shape and size of the side members and cross-links in view of the teaching of Bone '078 and since such a modification would have involved a mere change in shape and size of a component. A change in shape and size is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) and *In re Rose*, 105 USPQ 237 (CCPA 1955).

With respect to claims 11-18, the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 946, 966 (Fed. Cir. 1985).

A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. Products by Process claims are NOT limited to manipulations of the recited steps only to the structure implied by the steps.

Furthermore, Mori '106 teaches that rotary molding of plastics is a known alternative to injection molding, blow molding, extrusion molding, or other molding processes, see column 6, lines 43-57. Therefore, even if "rotary molding" results in different structural characteristics of the end product than other molding methods, it still would have been *prima facie* obvious at the time the invention was made to use "rotary molding" in Bone '078 as claimed since Mori '106 teaches that "rotary molding" is recognized as a useful technique for forming plastics.

Later in the Office Action, the Patent Office states the following:

Applicant's arguments filed January 26, 2004 have been fully considered but they are not persuasive. As admitted by applicant cross-links and side members that have both a flat surface and an arcuate surface are well known in the art. (Figures 1-6 embodiment of the instant application).

Therefore, with respect to the shape and size of the side members and cross-links it would have been an obvious matter of design choice to modify the shape and size of the side members and cross-links in view of the teaching of Bone '078 and since such a modification would have involved a mere change in shape and size of a component. A change in shape and size is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) and *In re Rose*, 105 USPQ 237 (CCPA 1955).

Contrary to applicant's argument the side members of Bone '078 [do] in fact have an augmented transverse cross-sectional size.

Products by Process claims are NOT limited to manipulations of the recited steps only to the structure implied by the steps. Applicant has not come [forward] with evidence establishing an unobvious difference between the claimed product and the prior art product. A statement or argument by the attorney is not factual evidence. See MPEP 716.01.

As a practical matter the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then [obtain] prior art products and [make] physical comparisons therewith. *In re Brown*, 173 USPQ 685, 688 (CCPA 1972).

Insofar as the subject rejection pertains to claims 12-18, 20, 23, 25-31 and 33-36, the rejection is moot in view of Applicants' cancellation herein of these claims. Insofar as the subject rejection pertains to claims 11, 19, 21-22, 24, 32, 37, 41-42 and 44-47, Applicants respectfully traverse the subject rejection.

Claim 11 has been amended herein and now recites "[a] length of continuously connected fastener stock fabricated according to a method comprising the steps of:

(a) providing a rotating molding wheel, said rotating molding wheel being provided with a peripheral impression comprising a pair of peripherally-extending side members interconnected by a plurality of cross-links wherein each of said peripherally-extending side members of said peripheral impression is generally semi-circular in transverse cross-section and wherein each of said cross-links of said peripheral impression is generally semi-circular in transverse cross-section;

(b) extruding molten plastic into the peripheral impression of said rotating molding wheel, with a layer of controlled film overlying the peripheral impression;

(c) allowing the molten plastic to solidify;

(d) using a knife in substantially elliptical contact with the peripheral impression to skive excess plastic from the rotating molding wheel, said knife having a bottom provided with a first cut-out portion aligned with one of said peripherally-extending side members so as to augment the transverse cross-sectional size thereof and a second cut-out portion aligned with the other of said peripherally-extending side members so as to augment the transverse cross-sectional size thereof, each of said first and second cut-out portions being generally semi-circular in cross-section, each of said first and second cut-out portions and each of said peripherally-extending side members of said peripheral impression being sized and shaped so that each cross-link of the continuously connected fastener stock asymmetrically bisects the side members of the continuously connected fastener stock; and

(e) removing the continuously connected fastener stock thus formed from the rotating molding wheel."

Claim 11 is patentable over the applied references because the applied references, taken individually or in combination, fail to teach or to suggest the claimed length of continuously connected fastener stock. In particular, Bone fails to teach or to suggest a length of continuously connected fastener stock wherein (i) the cross-links have both a flat surface and an arcuate surface and (ii) the cross-links asymmetrically bisect the side members. Instead, Bone discloses continuously connected fastener stock made by two different techniques. The first technique, which is shown in Figs. 1-4 and 49-50 of Bone and is described at col. 4, line 42 through col. 5, line 45, and at col. 12, line 55 through col. 13, line 2, of Bone involves punching or forming apertures in an extruded sheet of plastic. As can be appreciated, because of the punching process used to form the individual fasteners, the fastener stock made by this first technique typically has rectangular side

members and rectangular cross-links. The second technique, which is shown in Figs. 5-10 and 51-54 of Bone and is described at col. 5, line 46 through col. 6, line 35 and at col. 13, lines 3-14, of Bone involves injection molding a plurality of separately molded segments and then welding together the separately molded segments. Bone discloses that this second type of fastener attachment stock has round side members and round cross-links (see col.5, lines 63-65, of Bone) but may have round cross-links and rectangular side members or vice versa (see col. 6, lines 17-21, of Bone) or may have side members or cross-links taking "various other shapes such as oval, triangular, octagonal, etc." (see col. 6, lines 30-32, of Bone). It should be noted, however, that nothing in Bone teaches or suggests cross-links having both a flat surface and an arcuate surface or cross-links that asymmetrically bisect a side member.

The Patent Office concedes that Bone does not teach the shape of the claimed fastener stock but attempts to bridge the gap between Bone and the claimed invention by contending that "cross-links that have both a flat surface and an arcuate surface are well known in the art" and that "it would have been an obvious matter of design choice to modify the shape and size of the side members and cross-links in view of the teaching of Bone '078 and since such a modification would have involved a mere change in shape and size of a component." Applicants respectfully disagree with the Patent Office's line of reasoning. This is, in part, because the Patent Office is merely picking and choosing different features from prior art fastener stock in order to arrive at the claimed invention, without giving proper consideration as to what would have been fairly suggested to one of ordinary skill in the art at the time of the invention. For example, the Patent Office refers to the fact that fastener stock made by the conventional rotary molding technique has both a flat surface and an arcuate surface but fails to take into account the fact that, due to the skiving process used to

make such fastener stock, the fastener stock does not include side members whose transverse cross-sectional size is augmented. Considering the vastly different techniques that are used to form the Bone fastener stock and conventional rotary molded fastener stock and the fact that the shapes of the Bone fastener stock and conventional rotary molded fastener stock are directly related to their respective manufacturing techniques, there would have been no reason for a person of ordinary skill in the art to have modified the Bone fastener stock so as to include a cross-link having the shape of rotary molded fastener stock. Moreover, the Patent Office cannot dismiss the various structural differences between the Bone fastener stock and the claimed fastener stock merely by stating that "[a] change in shape and size is generally recognized as being within the level of ordinary skill in the art." If the Patent Office's rationale were proper, then virtually any modification to the Bone fastener stock that involved a change in shape or size would be unpatentable. Such reasoning, however, is belied by the fact that many patents have issued that involve a change in shape or size to the Bone fastener stock (see, for example, U.S. Patent Nos. 6,318,553 and 4,712,677, both of which are of record).

Therefore, for at least the above reasons, Applicants respectfully submit that the Patent Office has failed to establish a prima facie case of obviousness with respect to claim 11.

Claim 19, from which claim 21-22, 24, 32 and 37 depend, has been amended herein and now recites "[a] length of continuously connected fastener stock comprising:

(a) first and second side members; and

(b) a plurality of cross-links interconnecting said first and second side members, each of said cross-links having a flat surface and an arcuate surface;

(c) wherein said first side member is shaped to extend transversely beyond said flat surface and wherein said first side member is generally circular with at least one flattened surface in transverse cross-section."

Claim 19 is not rendered obvious over the applied references for at least the reasons that the applied references do not teach or suggest a length of continuously connected fastener stock comprising, among other things, (i) cross-links interconnecting first and second side members, each cross-link having a flat surface and an arcuate surface and (ii) the first side member being shaped to extend transversely beyond the flat surface of the cross-link, said first side member being generally circular with at least one flattened surface in transverse cross-section. The foregoing claim limitation regarding each cross-link having a flat surface and an arcuate surface is discussed above in connection with claim 11. With respect to the above claim limitation regarding the first side member being generally circular with at least one flattened surface in transverse cross-section, Applicants note that neither Bone nor Mori teaches or suggests a side member that is generally circular with at least one flattened surface. At best, Bone teaches circular side members or rectangular side members - not generally circular side members with at least one flattened surface. Moreover, nothing in the prior art would have motivated one of ordinary skill in the art to have modified the side members of Bone to provide the claimed shape.

Therefore, for at least the above reasons, Applicants respectfully submit that the Patent Office has failed to establish a prima facie case of obviousness with respect to claim 19.

Claim 41 recites "[a] length of continuously connected fastener stock comprising:

(a) first and second side members wherein said first side member is generally circularly shaped with at least one flattened surface in transverse cross-section; and

(b) a plurality of cross-links interconnecting said first and second side members, each of said cross-links having a flat surface;

(c) wherein said first side member is shaped to extend transversely beyond said flat surface with an arcuate surface."

Claim 41 is not rendered obvious over the applied references for at least the reason that the applied references do not teach or suggest a length of continuously connected fastener stock comprising, among other things, a first side member that is generally circular with at least one flattened surface in transverse cross-section. As noted above, Bone fails to teach this limitation, and Mori fails to cure this deficiency in Bone.

Therefore, for at least the above reasons, Applicants respectfully submit that the Patent Office has failed to establish a prima facie case of obviousness with respect to claim 41.

Claim 44, from which claims 45-47 depend, recites "[a] length of continuously connected fastener stock comprising:

(a) first and second side members, wherein said first side member is generally circular in transverse cross-section; and

(b) a plurality of cross-links interconnecting said first and second side members, each of said plurality of cross-links asymmetrically bisecting said first and second side members."

Claim 44 is not rendered obvious over the applied references for at least the reason that the applied references do not teach or suggest a length of continuously connected fastener stock comprising, among other things, a circular side member and a plurality of cross-links asymmetrically bisecting said circular side member. Instead, Bone discloses cross-links that **symmetrically** bisect a side member. Mori fails to cure this deficiency of Bone.

Therefore, for at least the above reasons, Applicants respectfully submit that the Patent Office has failed to establish a prima facie case of obviousness with respect to claim 44.


Accordingly, for at least the above reasons, the foregoing rejection should be withdrawn.

In conclusion, it is respectfully submitted that the present application is in condition for allowance. Prompt and favorable action is earnestly solicited.

If there are any fees due in connection with the filing of this paper that are not accounted for, the Examiner is authorized to charge the fees to our Deposit Account No. 11-1755. If a fee is required for an extension of time under 37 C.F.R. 1.136 that is not accounted for already, such an extension of time is requested and the fee should also be charged to our Deposit Account.


Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 21, 2005.


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